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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,498	01/31/2006	Tomoki Morioka	285615US0PCT	3694

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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER
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HOLLOMAN, NANNETTE

ART UNIT	PAPER NUMBER
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1612

NOTIFICATION DATE	DELIVERY MODE
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09/02/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
oblonpat@oblon.com  
jgardner@oblon.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/566,498	<b>Applicant(s)</b> MORIOKA, TOMOKI	
	<b>Examiner</b> NANNETTE HOLLOMAN	<b>Art Unit</b> 1612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 5,6,8,9,12 and 14-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5,6,8,9,12 and 14-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Applicants' arguments, filed June 10, 2010, have been fully considered. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

#### ***Claim Rejections - 35 USC § 103***

##### ***(Previous Rejection)***

1) Claims 5-6, 8-9 and 11-23 were rejected under 35 U.S.C. 103(a) as being unpatentable over Hinz (US Patent No. 5,785,962) in view of Fath (UK Patent No. GB 2321595 A). This rejection is maintained. Claims 11 and 13 are cancelled.

#### **Applicant's Arguments**

Applicant argues there is no motivation for one skilled in the art to select the specific shampoo of Hinz and combine it with the specific conditioner of Fath. Applicant further argues there is no rationale basis or evidence of how one skilled in the art would reasonably conclude that the combination would render obvious a hair treatment that improves the reduction in signs of bending. Applicant also argues the results between

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example 11 and Comparative Example 11 and Example 10 and Comparative Example 10. Applicant further argues the declaration explains the differences in recovery from the signs of braiding as reported as "significant". Applicant's arguments have been fully considered but they are not persuasive.

### **Examiner's Response**

It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. See MPEP 2144, IV. As previously asserted, the property of reducing bending is not a limitation of the instant claims and therefore the references do not have to specifically teach this property to encompass the instant claims. Furthermore, the teaching of Fath that the treatment of shampooed hair with the disclosed conditioners has improved wet and dry combability of the hair, a relaxed and soft touch and enhanced shine (p. 11, ex. 3) would provide one of ordinary skill the motivation to combine the conditioners with the shampoo of Hinz.

In regard to the comparison of Example 11 and 10, there appears to be no error analysis when reporting the results that Applicant considers unexpected. It appears the difference in Example 11 and Comparative Example 11 of (79 versus 71) recovery from the signs of bending just after treatment and (97 versus 92) one hour after treatment would appear to overlap depending on the % error. Thus Applicant has not shown that these values, especially 97 and 92 are not substantially the same.

When looking to Comparative Example 9 in Tables 3 and 4 in which Applicant has considered the "control" in which the hair shampoo does not contain components

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(a) and (c) and the conditioner does not contain components (b) and (c) the results of recovery from signs formed by bending right after and one hour after are 54 and 81 or 65.4° or 108.2°, respectively. Comparing Example 9 which contains the hair shampoo containing components (a) and (c) and the conditioner containing components (b) and (c) which gave the results of recovery from signs formed by bending right after and one hour after are 77 and 96 or 100.7° and 147.5°, respectively; showed a delta of 35.3 (100.7-65.4) and 39.3 (147.5-108.2) for right after and one hour after. When comparing these results to Example 11, which is a shampoo containing components (a) and (c) with a control conditioner gave a delta from the control (comparative example 9) of 25.1 (90.5-65.4) and 25.7 (133.9-108.2) for right after and one hour after and Example 10, which is a conditioner containing components (b) and (c) with a control shampoo gave a delta from the control (comparative example 9) of 9.8 (75.2-65.4) and 12.7 (120.9-108.2) for right after and one hour after. The results appear to be additive since the sum of the deltas from Example 11 and Example 10 correlate directly to the delta of the control (comparative example 9) and Example 9; when adding the results of Example 11 and 10 gives a delta value of 34.9 and 38.4 and the delta of comparative example 9 (control) and Example 9 gives the values of 35.3 and 39.3 for right after and one hour after. Therefore, the values appear to be additive. These values, when considering error appear to be no more than additive and no more than what one of ordinary skill in the art would expect.

Assuming, purely *arguendo*, that the results are unexpected, Applicant's claims encompass more compounds than that disclosed in the tables in the specification, i.e.

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component c, therefore the examples are not commensurate in scope with the instant claims.

2) Claim 24 was rejected under 35 U.S.C. 103(a) as being unpatentable over Hinz (US Patent No. 5,785,962) in view of Fath (UK Patent No. GB 2321595 A) s applied to claims 5-6, 8-9, 11-23 above, and further in view of Fukuchi (US Patent No. 5,888,488). This rejection is maintained.

Applicant has not responded to this rejection, and thus the rejection is maintained.

### ***Declaration***

The declaration under 37 CFR 1.132 filed June 10, 2010 is insufficient to overcome the rejection of claims 5-6, 8-9, 11-23 based upon 35 U.S.C. 103(a) as being unpatentable over Hinz (US Patent No. 5,785,962) in view of Fath (UK Patent No. GB 2321595 A) as set forth in the last Office action because:

Applicant alleges in the declaration that the difference Examples 9, 10 and 11 shows a resistance against the signs which have remained after braiding and a substantial improvement of suppleness are provided. Further alleging that not only are the differences in the recovery from signs of bending significant due to the increases in percent recovery and/degree of  $\theta$ , but such differences are also significant due to these increases being perceptible to the consumer as relates to the perceived suppleness of treated hair.

Examiner submits, when comparing the values of the control (comparative example 9) and example 9 with that of Examples 10 and 11, the differences appear to be no more than additive, see Examiner's Response supra for analysis. Furthermore, when comparing the difference from right to left after to one hour after of each example, the delta of each is substantially the same, in other words the hair would release the bend in each example substantially the same amount. Therefore, it can not be concluded that the results are unexpected.

Assuming, purely *arguendo*, that the results are unexpected, Applicant's claims encompass more compounds than that disclosed in the tables in the specification, i.e. component c may be polyols, aromatic alcohols and alkylene carbonates, therefore the examples are not commensurate in scope with the instant claims.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NANNETTE HOLLOMAN whose telephone number is (571) 270-5231. The examiner can normally be reached on Mon-Fri 800am-500pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick Krass can be reached on 571-272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. H./  
Examiner, Art Unit 1612

/Frederick Krass/  
Supervisory Patent Examiner, Art Unit 1612